

processed information with a second sponsored video message from the database for delivery to a second viewing station for viewing by the second-viewer together with multimedia.

### REMARKS

Claims 1-50 are pending in the present application. Claims 1-50 were rejected by the Examiner.

Based on the following Remarks, Applicant respectfully requests that the Examiner reconsider all outstanding objections and rejections and they be withdrawn.

#### The Amendments

The amendments are respectfully submitted to overcome the objections and rejections put forth by the Examiner. The amendments do not raise new issue or require new search. The Examiner is respectfully requested to enter the amendments and reconsider the application.

#### The Remarks

##### 35 USC § 112, Paragraph 2 Rejection

Claim 41 was rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. The rejection to Claim 41, which has been cancelled without prejudice, has been rendered moot.

##### 35 U.S.C. § 102(e) Rejection

Claims 23, 27, and 29-30 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,002,393, issued to Hite et al. (Hite).

The rejection to Claims 23, 27 and 29-30 have been rendered moot by the amendments above. Specifically, amended independent claim 23, and dependent claims 27 and 29-30, incorporate the demographic limitation into the claim, making a necessary element the incorporation of demographic information of the viewer into the message delivery processing and delivery system. In contrast, the Hite invention does not include the use of demographic information as a criteria for targeting its commercial delivery system. In fact, the Hite patent

discourages the use of such demographic information as “wasteful.” Col. 1, ln. 21-22. Instead, the Hite patent bases its pre-emption information only on the type of program being watched by the targeted viewer, not on lifestyle or demographic information. Col. 2, ln. 44-49. Because the Hite invention does not include the use of demographic information as a criteria for targeting its commercial delivery system, the Hite invention does not anticipate the instant application. Withdrawal of the rejection is respectfully requested.

35 U.S.C. § 103(a) Rejections

- 1. Claims 1-5, 9-10, 14-15 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,931,901 (Wolfe) in view of Hite.**

This rejection is respectfully traversed. To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. MPEP § 2142.

The present invention would not have been obvious over the combination of Wolfe and Hite because neither reference, nor their inappropriate combination, teaches or suggests the use of the internet to deliver sponsored video messages based on viewing behavior and demographic information of the viewer into broadcasts selected by the viewer. Applicant notes that the rejection to claims 2-4 is rendered moot because it has been cancelled without prejudice.

First, there is no motivation to make the combination suggested by the Examiner because the proposed combination of the references do not provide any teaching or suggestion to modify or combine the references as the Examiner has suggested.

Wolfe discloses a method for appending commercial messages to music content delivered to a listener’s workstation. Col. 1, ln. 14-19. Wolfe describes only appending commercial messages to the beginning and the end of the music media requested and delivered. Col. 6, ln. 34-38. The commercial message is selected based only upon the content of the music media requested. Col. 7, ln. 42-46.

Hite discloses a method and system for delivering targeted radio and television commercials based on the viewing content of the viewer. Hite does not disclose nor contemplate

the use of the internet as a means of categorizing or targeting the selected radio and television commercials.

Wolfe teaches away from the present invention because it **does not** include the use of demographic information of the viewer in the targeting of the sponsored appended messages, and only uses **viewing behavior** information as a source for selecting pre-emptable commercial messages. Col. 7, ln. 43-46. The invention disclosed in Wolfe does not utilize the “subscriber profile database” in decisional-making processes for choosing the targeted commercial message as contemplated by the present invention. Instead, Wolfe only looks at the content of the desired audio selection chosen by the user for determination of what advertising message may be appended. As stated in the specification:

The subscriber selects the content which he or she desires to receive, and the content is placed in the queue. **Based on the profile of the content**, a determination is made by the system as to which advertising messages may be delivered. Wolfe, col. 7, ln. 43-46.

That Wolfe only teaches the use of content information for deciding which commercial message to append is also evidenced through the claims of the invention. Claim 1 provides for:

- 1(a) creating a first database containing a large number of discrete data units *each of which has a related profile*;
- 1(b) creating a second database containing a variety of discrete advertising messages *each of which has a related profile*;
- 1(c) receiving requests for the data units from . . . users;
- 1(d) appending to the requested data units at least one of the said advertising messages **based upon a matching of profile criteria . . .**

Wolfe does not teach the coordination of a subscriber database in conjunction with information received on the viewing content of the viewer, as disclosed in the presently claimed invention. In other words, Wolfe only provides for matching profiles of the music media requested and the advertising messages in order to determine what message is appended to the music media, and as such teaches away from the present invention.

Moreover, Wolfe only contemplates appending *audio* information, a media and delivery means that greatly differs from the visual and audio multimedia contemplated by the present invention. The limitation in claim 1 of the present invention clearly contemplates the use of a “multimedia” commercial message targeted to the viewers, not a “unimedia” message (as in aural only) provided for by Wolfe. Applicant respectfully points out that the Examiner has stated

under her comments relating to the rejection of claim 12 (page 9) that the “Wolfe system only uses his system to transmit *audio* data.” Thus, the Wolfe system teaches away from the present invention because it does not teach the use of a multimedia commercial message nor the transmission of a multimedia-based data.

The combination of the lack of viewing content information, the type of information utilized for deciding what targeted message should be inserted and the delivery of only audio messages only serves to demonstrate that the Wolfe patent greatly teaches away from the present invention.

Adding Hite to Wolfe does not cure these deficiencies. Applicant respectfully disagrees with the Examiner’s suggestion that it would be obvious to one of skill in the art to simply modify Wolfe in view of Hite by adding viewing content to the computer system and reporting such viewing information back to the server. Moreover, Applicant stresses that there is no motivation to add Hite to Wolfe because Hite refers to a technique for delivering commercial messages in a divergent field than Wolfe. Hite teaches away from the present invention by disclosing the use of *unidirectional media*, i.e. traditional broadcast television and/or radio media. The use of unidirectional media for delivering visual commercial messages, or detecting viewing content by the user, is vastly different from the bi-directional media system, such as the internet, contemplated by the present invention. For example, as Hite discloses, the ability to poll viewers of a television broadcast via unidirectional media means must include the utilization of a second device, distinct from the listening and/or viewing device, such as a telephone. Col. 2, ln. 44-65. In contrast, the entire premise of the Internet and/or other network data protocols is that it allows for downstream and upstream communications from the viewing device itself.

Therefore, simply adding Hite cannot render obvious the present invention because it teaches away from the use of a bi-directional media. Combining the two references, thus, has no reasonable expectation of success because one of ordinary skill in the art could not take the teachings of Wolfe, which does not even contemplate a multimedia context including visual media, and simply modify it to Hite to incorporate visual media information into the targeted messages, where Hite does not even teach receipt and delivery of information by bi-directional means, such as the internet. MPEP § 2143.02. Moreover, Applicant respectfully asserts that one of ordinary skill in the art would not be motivated to combine the two references because of the

divergent nature of the two claimed inventions. The proposed modification of Wolfe, in view of Hite, in fact improperly modifies the principle of operation of the Wolfe patent. MPEP § 2143.01. As the Examiner is well aware of, combining references that “require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate” is impermissible. MPEP § 2143.01; *In re Ratti*, 270 F.2d 810, 813 (CCPA 1959).

Finally, adding Hite does not cure the deficiency of the use of demographic information, not only viewing information, for the selection of targeted messages to be delivered, which is provided for in the present invention. Thus, even with the improper combination of the two references, the combination does not teach or suggest all of the claim limitations in the present invention.

Reconsideration and withdrawal of the rejection is respectfully requested.

**2. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wolfe in view of U.S. Patent No. 6,014,694 (Aharoni).**

This rejection is respectfully traversed.

The present invention would not have been obvious over the combination of Wolfe and Aharoni because neither reference, nor their inappropriate combination, teaches or suggests the use of the internet to deliver sponsored video messages based on viewing behavior and demographic information of the viewer into broadcasts selected by the viewer, and further includes the downloading speed information of the viewing station of the first viewer in selecting a viewer multimedia message targeted to the viewer.

Wolfe, as mentioned above, teaches away from the present invention because it does not include the use of demographic information of the viewer in the targeting of the sponsored appended messages, and does not use visual information as a source for selecting appended commercial messages. In addition, Wolfe does not teach the use of delivering visual and audio multimedia messages to the user.

Adding Aharoni does not cure the deficiencies noted above and still fails to render obvious the presently claimed invention for the same reasons discussed above. Aharoni only teaches reporting the user’s downloading speed, and does not cure the deficiencies in Wolfe. To

establish prima facie obviousness, all of the claim limitations must be taught or suggested by the prior art. MPEP § 2143.01. Therefore the claim limitations of claim 11 is not taught or suggested by the prior art.

Reconsideration and withdrawal of the rejection is respectfully requested.

**3. Claims 12-13 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolfe in view of Hite and further in view of U.S. Patent Application No. 2001/0023436 (Srinivasan).**

This rejection is respectfully traversed.

The present invention would not have been obvious over the combination of Wolfe in view of Hite, and further in view of Srinivasan because none of the references, nor their inappropriate combination, teaches or suggests the use of the internet to deliver sponsored video messages based on viewing behavior and demographic information of the viewer into broadcasts selected by the viewer, and further includes a viewing station including a television, video-on-demand system or delivering the multimedia message to the viewing station simultaneously with the delivery of the multimedia content thereto.

Wolfe, as mentioned above, teaches away from the present invention because it does not include the use of demographic information of the viewer in the targeting of the sponsored appended messages, and does not use visual information as a source for selecting appended commercial messages. In addition, Wolfe does not teach the use of delivering visual and audio multimedia messages to the user.

Hite discloses a method and system for delivering targeted radio and television commercials based on the content of the viewer, but does not disclose nor contemplate the use of the internet as a means of categorizing or targeting the selected radio and television commercials. Applicant respectfully disagrees, as detailed above, that the combination of Wolfe in view of Hite renders obvious Claim 2, which has been amended to incorporate the elements of claim 2 into independent claim 1, as the Examiner has stated. The combination is improper because there is no motivation or suggestion to add Hite to Wolfe in light of the teachings of the prior art references. MPEP § 2143.01. Hite refers to a technique for delivering commercial messages in a divergent field than Wolfe. Hite teaches away from the present invention by disclosing the use of

*unidirectional media*, i.e. traditional broadcast television and/or radio media. The use of unidirectional media for delivering visual commercial messages, or detecting viewing content by the user, is vastly different from the bi-directional media system, such as the internet, contemplated by the present invention. For example, as Hite discloses, the ability to poll viewers of a television broadcast via unidirectional media means must include the utilization of a second device, distinct from the listening and/or viewing device, such as the telephone. Col. 2, ln. 44-65. In contrast, the entire premise of the Internet and/or other network data protocols is that it allows for downstream and upstream communications from the viewing device itself.

Therefore, simply adding Hite cannot render obvious the present invention because it teaches away from the use of a bi-directional media. Combining the two references, thus, has no reasonable expectation of success because one of ordinary skill in the art could not take the teachings of Wolfe, which does not even contemplate a multimedia context including visual media, and simply modify it to Hite to incorporate visual media information into the targeted messages, where Hite does not even teach receipt and delivery of information by bi-directional means, such as the internet. MPEP § 2143.02. Moreover, Applicant respectfully asserts that one of ordinary skill in the art would not be motivated to combine the two references because of the divergent nature of the two claimed inventions. The proposed modification of Wolfe, in view of Hite, in fact improperly modifies the principle of operation of the Wolfe patent. MPEP § 2143.01. As the Examiner is well aware of, combining references that “require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate” is impermissible. MPEP § 2143.01; *In re Ratti*, 270 F.2d 810, 813 (CCPA 1959).

In addition, as noted above, even with the improper combination of the two references, the combination does not teach or suggest all of the claim limitations in the present invention, which is necessary for making a prima facie case of obviousness. MPEP § 2143.01.

Adding Srinivasan to Wolfe in view of Hite does not cure the deficiencies noted above and still fails to render obvious the presently claimed invention for the same reasons discussed above. To establish prima facie obviousness, all of the claim limitations must be taught or suggested by the prior art. MPEP § 2143.01. The combination of Srinivasan does not cure the

deficiencies of Wolfe in view of Hite, and therefore the claim limitations of claims 12-13 and 20 are not taught or suggested by the prior art.

Reconsideration and withdrawal of the rejection is respectfully requested.

**4. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wolfe in view of Hite and further in view of U.S. Patent No. 5,848,396 (Gerace).**

This rejection is respectfully traversed.

The present invention would not have been obvious over the combination of Wolfe in view of Hite, and further in view of Gerace because none of the references, nor their inappropriate combination, teaches or suggests the use of the internet to deliver sponsored video messages based on viewing behavior and demographic information of the viewer into broadcasts selected by the viewer, including the time of viewing by the first viewer.

Wolfe, as mentioned above, teaches away from the present invention because it does not include the use of demographic information of the viewer in the targeting of the sponsored appended messages, and does not use visual information as a source for selecting appended commercial messages. In addition, as noted above, Wolfe does not teach the use of delivering visual and audio multimedia messages to the user.

Hite discloses a method and system for delivering targeted radio and television commercials based on the content of the viewer, but does not disclose nor contemplate the use of the internet as a means of categorizing or targeting the selected radio and television commercials. Applicant respectfully disagrees, as detailed above, that the combination of Wolfe in view of Hite renders obvious Claim 1 as the Examiner has stated. The combination is improper because the references do not suggest or motivate such a combination, as noted above. MPEP § 2143.01. Moreover, even with the improper combination of the two references, the combination does not teach or suggest all of the claim limitations in the present invention, which is necessary for making a prima facie case of obviousness. MPEP § 2143.01.

Adding Gerace does not cure the deficiencies noted above and still fails to render obvious the presently claimed invention for the same reasons discussed above. To establish prima facie obviousness, all of the claim limitations must be taught or suggested by the prior art. MPEP §



2143.01. The combination of Gerace does not cure the deficiencies of Wolfe in view of Hite, and therefore the claim limitations of claim 17 are not taught or suggested by the prior art.

Reconsideration and withdrawal of the rejection is respectfully requested.

**5. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wolfe in view of Hite and further in view of U.S Patent No. 5,801,747 (Bedard).**

This rejection is respectfully traversed.

The present invention would not have been obvious over the combination of Wolfe in view of Hite, and further in view of Bedard because none of the references, nor their inappropriate combination, teaches or suggests the use of the internet to deliver sponsored video messages based on viewing behavior and demographic information of the viewer into broadcasts selected by the viewer, including information relating to the length of viewing time of the first viewer at the viewing station.

Wolfe, as mentioned above, teaches away from the present invention because it does not include the use of demographic information of the viewer in the targeting of the sponsored appended messages, and does not use visual information as a source for selecting appended commercial messages. In addition, Wolfe does not teach the use of delivering visual and audio multimedia messages to the user.

Hite discloses a method and system for delivering targeted radio and television commercials based on the content of the viewer, but does not disclose nor contemplate the use of the internet as a means of categorizing or targeting the selected radio and television commercials. Applicant respectfully disagrees, as detailed above, that the combination of Wolfe in view of Hite renders obvious Claim 1 as the Examiner has stated. The combination is improper because the references do not suggest or motivate such a combination, as noted above. MPEP § 2143.01. Moreover, even with the improper combination of the two references, the combination does not teach or suggest all of the claim limitations in the present invention, which is necessary for making a prima facie case of obviousness. MPEP § 2143.01.

Adding Bedard does not cure the deficiencies noted above and still fails to render obvious the presently claimed invention for the same reasons discussed above. To establish prima facie obviousness, all of the claim limitations must be taught or suggested by the prior art. MPEP §

2143.01. The combination of Bedard does not cure the deficiencies of Wolfe in view of Hite, and therefore the claim limitations of claim 17 are not taught or suggested by the prior art.

Reconsideration and withdrawal of the rejection is respectfully requested.

**6. Claim 19, and claim 21, are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolfe in view of Hite and further in view of U.S. Patent No. 6,182,050 (Ballard).**

This rejection is respectfully traversed.

The present invention would not have been obvious over the combination of Wolfe in view of Hite, and further in view of Ballard because none of the references, nor their inappropriate combination, teaches or suggests the use of the internet to deliver sponsored video messages based on viewing behavior and demographic information of the viewer into broadcasts selected by the viewer, and further presents the multimedia message when there is a break in the availability of the multimedia content for presentation at the viewing station or includes pre-caching of the multimedia message for presentation when multimedia content is generally not available for presentation.

Wolfe, as mentioned above, teaches away from the present invention because it does not include the use of demographic information of the viewer in the targeting of the sponsored appended messages, and does not use visual information as a source for selecting appended commercial messages. In addition, Wolfe does not teach the use of delivering visual and audio multimedia messages to the user.

Hite discloses a method and system for delivering targeted radio and television commercials based on the content of the viewer, but does not disclose nor contemplate the use of the internet as a means of categorizing or targeting the selected radio and television commercials. Applicant respectfully disagrees, as detailed above, that the combination of Wolfe in view of Hite renders obvious Claim 1 as the Examiner has stated. The combination is improper because the references do not suggest or motivate such a combination, as noted above. MPEP § 2143.01. Moreover, even with the improper combination of the two references, the combination does not teach or suggest all of the claim limitations in the present invention, which is necessary for making a prima facie case of obviousness. MPEP § 2143.01.

Adding Ballard does not cure the deficiencies noted above and still fails to render obvious the presently claimed invention for the same reasons discussed above. To establish prima facie obviousness, all of the claim limitations must be taught or suggested by the prior art. MPEP § 2143.01. The combination of Ballard does not cure the deficiencies of Wolfe in view of Hite, and therefore the claim limitations of claim 17 are not taught or suggested by the prior art.

Reconsideration and withdrawal of the rejection is respectfully requested.

**7. Claims 23, 24-26 and 28 are rejected as being unpatentable over Hite in view of Gerace.**

This rejection is respectfully traversed.

The present invention would not have been obvious over the combination of Hite in view of Gerace because neither reference, nor their inappropriate combination, teaches or suggests the use of the internet to deliver sponsored video messages based on viewing behavior and demographic information of the viewer into broadcasts selected by the viewer. Moreover, the amendments to claim 23 renders moot the 102(e) rejection in view of Hite in regards to the demographic information element added to claims 26 and 28. Applicant notes that the rejection to claim 24 is rendered moot because it has been cancelled without prejudice.

Hite discloses a method and system for delivering targeted radio and television commercials based on the content of the viewer, but does not disclose nor contemplate the use of the internet as a means of categorizing or targeting the selected radio and television commercials. Hite teaches away from the present invention by disclosing the use of *unidirectional media*, i.e. traditional broadcast television and/or radio media. The use of unidirectional media for delivering visual commercial messages, or detecting viewing content by the user is vastly different from the bi-directional media system, such as the internet, contemplated by the present invention. For example, as Hite discloses, the ability to poll viewers of a television broadcast via unidirectional media means must include the utilization of a second device, distinct from the listening and/or viewing device, such as the telephone. Col. 2, ln. 44-65. In contrast, the entire premise of the Internet and/or other network data protocols is that it allows for downstream and upstream communications from the viewing device itself. Therefore, Hite teaches away from the

present invention by teaching a media that is substantially different than that disclosed in the present invention.

Applicant respectfully asserts that no motivation exists for adding Gerace to the combination since Gerace refers only to a technique within the context of the internet system, not within a unidirectional media as contemplated by Hite above. MPEP § 2143.01 requires a suggestion or motivation to modify the prior art references in order to render obvious the claimed invention, either in the nature of the problem to be solved, the teachings of the prior art or the knowledge of persons of ordinary skill in the art. Combining Hite in view of Gerace does not render obvious the present invention because the prior art references arise from divergent fields. As noted above, Hite teaches away by disclosing a system relying on a unidirectional media, not a bi-directional media disclosed by the present invention. Gerace, in contrast, teaches a system relying on a bi-directional media, i.e. the internet. The proposed modification of Hite in view of Gerace, in fact, improperly modifies the principle of operation of the Hite patent. MPEP § 2143.01. As the Examiner is well aware of, combining references that “require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate” is impermissible. MPEP § 2143.01; *In re Ratti*, 270 F.2d 810, 813 (CCPA 1959).

In addition, the combination is improper because Hite teaches away from the present invention by disclosing that the use of demographic information in selecting commercial messages for delivery is “wasteful.” Hite patent, col. 1, ln. 21-22. Combining the demographic information of Gerace is improper because Hite teaches away by discouraging from the use of demographic information in selecting commercial messages. Thus, there is no motivation or suggestion to combine the references, and the combination of the references is improper. MPEP § 2143.01.

Moreover, adding Gerace does not cure the deficiencies in Hite noted above, and fails to render obvious the presently claimed invention for the same reasons discussed above. To establish prima facie obviousness, all of the claim limitations must be taught or suggested by the prior art. MPEP § 2143.01. The combination of Gerace does not render the claimed invention obvious in view of Hite because the element of delivering a multimedia message in an internet context is still lacking from the improper combination.

Therefore the claim limitations of claims 23, 25-26 and 28 are not taught or suggested by the prior art. Applicant respectfully requests reconsideration of this rejection.

**8. Claim 31, and Claims 32-33, are rejected under U.S.C. 103(a) as being unpatentable over Wolfe in view of Hite.**

This rejection is respectfully traversed.

The present invention would not have been obvious over the combination of Wolfe in view of Hite because neither reference, nor their inappropriate combination, teaches or suggest the use of the internet to deliver sponsored video messages based on viewing behavior and demographic information of the viewer into broadcasts selected by the viewer. Applicant respectfully points out to the Examiner that amended claim 31 now expressly incorporates the use of demographic information in selecting commercial messages for delivering to viewers or users. The rejection to claim 32 is rendered moot because it has been cancelled, however, the rejection to claim 33 is no longer valid because of the incorporation of the demographic information into independent claim 31. Applicant respectfully requests reconsideration of the rejection to claim 33 in light of this amendment as well as the following remarks.

First, there is no motivation to make the combination suggested by the Examiner because the proposed combination of the references do not provide any teaching or suggestion to modify or combine the references as the Examiner has suggested.

Wolfe, as mentioned above, teaches away from the present invention because it does not teach the use of delivering visual and audio multimedia messages to the user. Wolfe only teaches the use of a single media delivery system, i.e. audio messages appended to sponsored commercial messages.

Hite, as noted above, discloses a method and system for delivering targeted radio and television commercials based on the viewing content of the viewer. Hite does not disclose nor contemplate the use of the internet as a means of categorizing or targeting the selected radio and television commercials. Moreover, Hite teaches away from the present invention because it discourages the use of demographic information for targeting select commercial messages, as noted above.

As extensively noted above, both Wolfe and Hite teach away from the present invention by not disclosing a means of incorporating demographic information into the selection process, provided for in the present invention and amended claims. The combination of Wolfe and Hite does not cure the deficiencies noted above, and therefore the claim limitations of claim 31-33 are not taught or suggested by the prior art. MPEP § 2143.01.

Moreover, Applicant asserts that combining the references is improper because both references contain no suggestion or motivation for the combination, and in fact discourage such combination. Hite discourages the use of demographic information for the selection of commercial messages to be delivered, and thus critically teaches away from the invention. Hite, col. 1, ln. 21-22. Even if the limitation of the demographic information could be provided by the references, which it does not, Hite explicitly teaches against the use of such information in the selection of messages and does not suggest or motivate such a combination contemplated by the Examiner. Therefore, the combination of the references is improper in light of the teachings of Hite, and thus cannot be made. MPEP § 2141.02.

Applicant also respectfully disagrees with the Examiner's suggestion that it would be obvious to one of skill in the art to simply modify Wolfe in view of Hite by adding viewing content to the computer system and reporting viewing information back to the server. Applicant respectfully points out to the Examiner that one of ordinary skill in the art would not be motivated to combine the two references because doing so would improperly change the principle of operation of the reference. MPEP § 2143.01. Combining the unidirectional media system of Hite would improperly change the principle of operation of the bi-directional media system of Wolfe, and vice-versa. Both systems, as noted above, are vastly different in terms of the delivery of visual commercial messages contemplated by the present invention. For example, as Hite discloses, the ability to poll viewers of a television broadcast via unidirectional means must include the utilization of a second device, distinct from the listening and/or viewing device, such as a telephone. Hite, col. 2, ln. 44-65. In contrast, the entire premise of the Internet and/or other network data protocols is that it allows for downstream and upstream communications from the viewing device itself. Therefore, simply adding Hite, which does not even contemplate visual media within an internet context, cannot render obvious the present invention because it teaches away from the use of a bi-directional media.

Finally, adding Hite does not cure the deficiency of the use of demographic information, not only viewing information, for the selection of targeted messages to be delivered, which is provided for in the present invention. Thus, even with the improper combination of the two references, the combination does not teach or suggest all of the claim limitations in the present invention.

Applicant respectfully requests that the rejection be reconsidered in light of the foregoing comments and remarks.

**9. Claims 34-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolfe in view of Bedard (U.S. Patent No. 5,801,747).**

This rejection is respectfully traversed.

The present invention would not have been obvious over the combination of Wolfe in view of Bedard because neither reference, nor their inappropriate combination, teaches a processing server programmed to deliver a sponsored commercial message, chosen using a viewer's viewing information and demographic information, the delivery of the sponsored message to be made in conjunction with a chosen multimedia. Applicant notes that the rejection to claim 35 is rendered moot because it is cancelled.

Wolfe discloses a method for appending commercial message to music content delivered to a listener's workstation. Wolfe, col. 1, ln. 14-19. Wolfe describes only appending commercial messages to the beginning and the end of the music media requested and delivered. Wolfe, col. 6, ln. 34-38. The commercial message is selected based only upon the content of the music media requested. Wolfe, col. 7, ln. 42-46.

Wolfe teaches away from the present invention because it does not teach the use of demographic information of the viewer in the targeting of the sponsored appended messages, and only uses viewing behavior information as a source for selecting pre-emptable commercial messages. Wolfe, col. 7, ln 43-46. Applicant respectfully points out that the invention disclosed in Wolfe does not utilize the "subscriber profile database" in decisional-making processes for choosing the targeted commercial message as contemplated by the present invention. Instead, Wolfe only looks at the content of the desired audio selection chosen by the user for determination of what advertising message may be appended.

The subscriber selects the content which he or she desires to receive, and the content is placed in the queue. **Based on the profile of the content**, a determination is made by the system as to which advertising messages may be delivered. Wolfe, col. 7, ln. 43-46.

That Wolfe only teaches the use of content information for deciding which commercial message to append is also evidenced through the claims of the invention. Claim 1 provides for:

- 1(a) creating a first database containing a large number of discrete data units *each of which has a related profile*;
- 1(b) creating a second database containing a variety of discrete advertising messages *each of which has a related profile*;
- 1(c) receiving requests for the data units from . . . users;
- 1(d) appending to the requested data units at least one of the said advertising messages **based upon a matching of profile criteria . . .**

In other words, Wolfe only provides for matching profiles of the music media requested and the advertising messages in order to determine what message is appended to the music media. Wolfe does not provide for the use of demographic information, as in the present invention, and as such teaches away from the present invention.

Moreover, Wolfe only contemplates appending *audio* information to an audio system, a media and delivery means that greatly differs from the visual and audio multimedia contemplated by the present invention. Applicant respectfully points out that the Examiner has stated under her comments relating to the rejection of claim 12 (page 9) that the "Wolfe system only uses his system to transmit *audio* data." Thus, the Wolfe system does not teach the use of a video commercial message nor the transmission of multimedia-based data, a limitation required in the present invention.

Adding Bedard does not cure the deficiencies noted above, and fails to render obvious the presently claimed invention for the same reasons discussed above. Thus, even with the improper combination of the two references, the combination does not teach or suggest all of the claim limitations in the present invention.

Reconsideration and withdrawal of the rejection is respectfully requested.

**10. Claim 39, and Claims 40, 42-43, are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolfe in view of Hite and further in view of U.S. Patent No. 5,572,643 (Judson).**



This rejection is respectfully traversed. The present invention would not have been rendered obvious over the combination of Wolfe in view of Hite, and further in view of Judson because none of the references, nor their inappropriate combination, teaches or suggests the use of the internet to deliver sponsored video messages to viewers into broadcasts selected by the viewer.

Wolfe, as mentioned above, teaches away from the present invention because it does not teach the use of delivering visual and audio multimedia messages to the user. Wolfe only teaches the use of a single media delivery system, i.e. audio messages appended to sponsored commercial messages.

Hite discloses a method and system for delivering targeted radio and television commercials based on the content of the viewer, but does not disclose nor contemplate the use of the internet as a means of categorizing or targeting the selected radio and television commercials. Applicant respectfully disagrees, as detailed above, that the combination of Wolfe in view of Hite renders obvious Claim 1 as the Examiner has stated. The combination is improper because the references do not suggest or motivate such a combination, as noted above. MPEP § 2143.01.

Moreover, Applicant respectfully asserts that no motivation exists for adding Judson to the combination since Judson refers only to a technique for inserting messages into a browser environment, not a multimedia playing system. Judson shows precaching of static messages within a browser application. See Judson, col. 1, ln. 59-63. Applicant respectfully points out to the Examiner that the precaching of messages within a browser is fundamentally different from the delivery of messages inside a multimedia playing device. The delivery of multimedia messages inside a multimedia playing device requires the use of processing servers and the like to accomplish the complex and intricate coordination of the selection of messages for a given viewer. Pre-caching selected messages based upon viewing and demographic information require the retrieval of messages within a commercial database matching parameters according to the commercial sponsor. The present invention also contemplates the delivery of the message at points during the delivery of the multimedia message where the system detects that the cache of multimedia content is below a predetermined amount or when the cache depletion rate exceeds a predetermined speed. See Fenne application, pg. 9, ln. 25-29.

In contrast, appending messages to a hypertext document involves the use of masking the document via HTML comments or tags with information objects that do not appear to the user's display, i.e. the messages are pre-attached to the web page selected. See Judson, col. 2, ln. 6-11. Thus, the messages are not "pre-cached" in the same manner as contemplated by the present invention. The messages only appear in conjunction with the selection of another web page, and automatically appear regardless of the length of time it takes to download the next page. In addition, Judson only contemplates the insertion of static messages, i.e. text information and simple graphics. Judson does not contemplate the use of multimedia messages, as disclosed by the present invention.

Thus, Applicant respectfully disagrees, as detailed above, that the combination of Wolfe in view of Hite, and further in view of Judson, renders obvious Claims 39-40 and 42-43 as the Examiner has stated. Even with the improper combination of the two references, the combination does not teach or suggest all of the claim limitations in the present invention, which is necessary for making a prima facie case of obviousness. Delivering a multimedia message within the confines of a multimedia playing system through the internet is not provided for by the improper combination of the references. Claims 39-40 and 42-43 are not rendered obvious by the prior art references.

Furthermore, there is no motivation to make the combination suggested by the Examiner because the proposed combination does not result in any improvement or useful purpose. Therefore, the prior art does not suggest the desirability of the proposed combination, and the invention is not obvious over this combination of references. MPEP § 2143.01.

Reconsideration and withdrawal of the rejection is respectfully requested.

**11. Claims 44-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolfe in view of Hite and further in view of Judson.**

This rejection is respectfully traversed.

The present invention would not have been obvious over the combination of Wolfe in view of Hite, and further in view of Judson because none of the references, nor their inappropriate combination, teaches or suggests the use of the internet to deliver sponsored video

messages based on viewing behavior and demographic information of the viewer into broadcasts selected by the viewer.

Wolfe, as mentioned above, teaches away from the present invention because it does not include the use of demographic information of the viewer in the targeting of the sponsored appended messages, and does not use visual information as a source for selecting appended commercial messages. In addition, Wolfe does not teach the use of delivering visual and audio multimedia messages to the user.

Hite discloses a method and system for delivering targeted radio and television commercials based on the content of the viewer, but does not disclose nor contemplate the use of the internet as a means of categorizing or targeting the selected radio and television commercials. Applicant respectfully disagrees, as detailed above, that the combination of Wolfe in view of Hite renders obvious Claim 44 as the Examiner has stated. Even with the improper combination of the two references, the combination does not teach or suggest all of the claim limitations in the present invention, which is necessary for making a prima facie case of obviousness.

Furthermore, Applicant respectfully asserts that no motivation exists for adding Judson to the combination since Judson refers only to a technique for inserting messages into a browser environment, not a multimedia playing system. Judson shows precaching of static messages within a browser application. See Judson patent, col. 1, ln. 59-63. Applicant respectfully points out to the Examiner that the precaching of messages within a browser is fundamentally different from the delivery of messages inside a multimedia playing device. The delivery of multimedia messages inside a multimedia playing device requires the use of processing servers and the like to accomplish the complex and intricate coordination of the selection of messages for a given viewer. Pre-caching selected messages based upon viewing and demographic information require the retrieval of messages within a commercial database matching set parameters according to the commercial sponsor. The present invention also contemplates the delivery of the message at points during the delivery of the multimedia message where the system detects that the cache of multimedia content is below a predetermined amount or when the cache depletion rate exceeds a predetermined speed. See Fenne application, pg. 9, ln. 25-29.

In contrast, appending messages to a hypertext document involves the use of masking the document via HTML comments or tags with information objects that do not appear to the user's

display, i.e. the messages are pre-attached to the web page selected. See Judson patent, col. 2, ln. 6-11. Thus, the messages are not “pre-cached” in the same manner as contemplated by the present invention. The messages only appear in conjunction with the selection of another web page, and automatically appear regardless of the length of time it takes to download the next page. In addition, Judson only contemplates the insertion of static messages, i.e. text information and simple graphics. Judson does not contemplate the use of multimedia messages, as disclosed by the present invention.

Thus, Applicant respectfully disagrees, as detailed above, that the combination of Wolfe in view of Hite, and further in view of Judson, renders obvious Claims 44-50 as the Examiner has stated. Even with the improper combination of the two references, the combination does not teach or suggest all of the claim limitations in the present invention, which is necessary for making a prima facie case of obviousness. Both the demographic information limitation, as well as delivering a multimedia message within the confines of a multimedia playing system through the internet are not provided for by the improper combination of the references. Claims 44-50 are not rendered obvious by the prior art references.

Furthermore, there is no motivation to make the combination suggested by the Examiner because the proposed combination does not result in any improvement or useful purpose. Therefore, the prior art does not suggest the desirability of the proposed combination, and the invention is not obvious over this combination of references. MPEP § 2143.01.

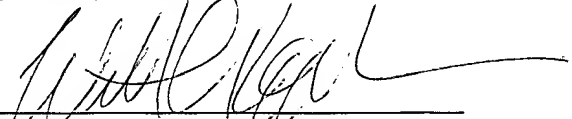
Reconsideration and withdrawal of the rejection is respectfully requested.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "**Version with markings to show changes made.**"

Enclosed with this response is a petition for a three-month extension of time including authorization for the prescribed fee. If any other fees are due with this response, please charge the same to our Deposit Account No. **08-3038**, referencing Docket No. 05742-0004-NPUS00.

Respectfully submitted,

Date: April 7, 2003

  
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VERSION WITH MARKINGS TO SHOW CHANGES MADE

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Technology Center 2600

1. A message delivery method, comprising:

- (a) delivering viewing behavior information of a first viewer from one or more viewing stations which the first viewer is using to a processing system;
- (b) delivering demographic information regarding the first viewer to the processing system;
- (c[b]) delivering viewing behavior information of a second viewer from one or more viewing stations which the second viewer is using to the processing system;
- (d) delivering demographic information regarding the second viewer to the processing system;
- (e[c]) processing the first viewer viewing behavior information and demographic information regarding the first viewer delivered to the processing system to select a first viewer multimedia message targeted to the first viewer;
- (f[d]) processing the second viewer viewing behavior information and demographic information regarding the second viewer delivered to the processing system to select a second viewer multimedia message targeted to the second viewer; and
- (g[e]) delivering the first viewer multimedia message to a viewing station of the first viewer.

5. The method of claim 1[2] wherein the processing of (e[c]) and (f[d]) are at the processing system.

6. The method of claim 1[2] wherein (a) includes the viewing behavior defining first viewing behavior and the using is at a first use time, and (e[c]) includes the message defining a first message; and further comprising:

- (h) delivering second viewing behavior information of the first viewer from a viewing station, which the first viewer is using at a second use time after the first use time, to the processing system;

- (i) processing, at the processing system, at least the first viewer demographic information and the first viewer second viewing behavior information to select a first viewer multimedia second message; and
  - (j) delivering the second message to a viewing station of the first viewer for viewing thereat.
- 9. The method of claim 1[2] further comprising delivering the second viewer multimedia message to a viewing station of the second viewer.
- 10. The method of claim 1 wherein (g[e]) includes delivering the message with multimedia content to the viewing station of the first viewer.
- 11. The method of claim 1[2], wherein (a) includes the viewing behavior information including downloading speed information of the viewing station which the first viewer is using.
- 12. The method of claim 1[2] wherein (g[e]) includes the viewing station including a television.
- 19. The method of claim 1 wherein (g[e]) includes presenting the first viewer multimedia messages when there is a break in the availability of the multimedia content for presentation at the viewing station.
- 20. The method of claim 1 wherein (g[e]) includes delivering the first viewer multimedia message to the viewing station simultaneously with the delivers of the multimedia content thereto.
- 21. The method of claim 1 wherein (g[e]) includes pre-caching the first viewer multimedia message for presentation at the viewing station when multimedia content to be viewed is generally not available for presentation.

23. A message delivery system, comprising:
- a processing system;
  - means for delivering to the processing system viewing information on the viewing of multimedia content by a first viewer;
  - means for displaying at a viewing station multimedia content for viewing by the first viewer;
  - wherein the processing system uses the viewing information to select a desired sponsored video message; [and]
  - means for delivering demographic information about the first viewer to the processing system;
  - wherein the processing system also uses the demographic information to select the desired message; and
  - means for delivering the message to a viewing station for viewing by the first viewer in conjunction with the viewing by the first viewer of the multimedia content.
- 25 The system of claim 23[24] further comprising:
- means for delivering second-viewer demographic information on a second viewer to the processing system;
  - means for delivering to the processing system second-viewer viewing information on the viewing by the second viewer of multimedia content;
  - means for displaying at a viewing station multimedia content for viewing by the second viewer;
  - wherein the processing system uses the second-viewer demographic information together with the second-viewer viewing information to select a desired second-viewer sponsored video message different from the message for the first viewer;
  - and



means for delivering the second-viewer message to a viewing station for viewing by the second viewer in conjunction with the viewing by the second viewer of the multimedia content.

31. A message delivery system, comprising:

first and second viewing stations;

a multimedia content server;

a message server including a plurality of different sponsored video messages;

a processing server which processes multimedia viewing information about a first viewer and therefrom selects a first message from the plurality of messages;

wherein the processing server also processes demographic information of the first viewer to select the first message;

the first station presenting the first message from the message server and multimedia content from the multimedia content server for viewing by the first viewer;

the processing server processing multimedia viewing information about a second viewer and therefrom selecting a second message from the plurality of messages;

[and]

wherein the processing server also processes demographic information of the second viewer to select the second message; and

the second station presenting the second message from the message server and multimedia content from the multimedia content server for viewing by the second server.

34. A processing server programmed to:

receive multimedia first-viewer viewing information and first-viewer demographic information relative to a first-viewer;

process the first-viewer viewing information and first-viewer demographic information to obtain first processed information, and associate the first processed information with a first sponsored video message from a database of messages for

delivery to a first viewing station for viewing by the first-viewer together with multimedia;  
receive second-viewer multimedia viewing information and second-viewer demographic information relative to a second viewer; and  
process the second-viewer viewing information and second-viewer demographic information to obtain second processed information and associate the second processed information with a second sponsored video message from the database for delivery to a second viewing station for viewing by the second-viewer together with multimedia.